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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/730,244  | 12/08/2003  | Stephen C. Tulley    | 00-019-C1           | 2482             |
| 22927   | 7590        | 12/13/2006           | EXAMINER            |                  |
| WALKER DIGITAL<br>2 HIGH RIDGE PARK<br>STAMFORD, CT 06905 |             |                      | LEIVA, FRANK M      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3714                |                  |

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |   |
|------------------------------|------------------------|---------------------|---|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |   |
|                              | 10/730,244             | TULLEY ET AL.       |   |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     | . |
|                              | Frank M. Leiva         | 3714                |   |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 6<sup>th</sup> of March, 2006.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-67 is/are pending in the application.
  - 4a) Of the above claim(s) 1-44 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 45-67 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/27/2004 has been entered.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 45-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, 12 and 33 of U.S. Patent No. 6,688,976. Although the conflicting claims are not identical, they are not patentably distinct

from each other because both claim methods for facilitating a lottery ticket transaction involving receiving requests to purchase a lottery ticket, receiving an indication that the lottery number combination is to be associated with only a limited number of occurrences for the drawing and determining a price associated with the ticket based on the received indication and agreement that not more than the limited number of occurrences of the lottery number combination will be sold. The only difference between claim 45 of the present application and claim 1 of the patent is that in the application, it recites "operator terminal" while the patent recites "a first player". It would have been obvious to a person of ordinary skill in the art that a player could operate an "operator terminal" thereby meeting both the claims in the application and in the parent. It is well known throughout the art that operator terminals generally have human interaction from players; therefore it is obvious that the operator terminal could include a player. Consequently, the present application is an obvious variant of the original patent and therefore, constitutes double patenting. With regards to claim 48 in the application, the claim is identical to claim 33 of the patent except for the last limitation. Claim 48 recites "preventing the lottery number combination from being associated with at least one additional lottery ticket" while claim 33 of the patent recites, "...an agreement that no other lottery tickets with the lottery number combination will be sold for the lottery drawing." One of ordinary skill in the art, would clearly know that when an agreement is reached no other lottery tickets with the lottery number combination should be sold for the lottery drawing, one would obviously prevent the lottery number combination from being associated with at least one additional lottery ticket in order to comply with the

agreement. Therefore, the act of "prevention" is obvious to one of ordinary skill in the art and consequently, the claim constitutes double patenting.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 45-64, 66, 67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. All of the claims generally recite method steps including the following

"...receiving a request to purchase a lottery ticket..." and "...determining a price associated with a lottery ticket..." Applicant's method claims do not state that the invention outputs any information, such as the price, in printed form to a person or a display. None of the method steps allows Applicant's invention to be considered tangible and not merely an abstract idea. For example, many of the claims state the limitation of "determining a price" but what happens after the price is determined, is it printed out, displayed, etc. Under 35 U.S.C. 101 the claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993). A process that

consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, and 30 USPQ2d at 1459.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 45-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scanlon, U.S. Patent No. 4,922,522 in view of "Our Opinion State scamming lottery buyers", York Daily Record, April 9, 1998, thereafter known as Our Opinion 4/9/98.

Scanlon teaches:

9. Regarding claims 45-50, 52, 59-61, and 66, Scanlon teaches a method of facilitating a lottery ticket, receiving a request from an operator, the operator able to choose the number of occurrences and a price for such a transaction in accordance to the purchase, In column 2:57-63 Scanlon expresses a customers ability to arrange a purchase, select the numbers and the quantity of times to play (occurrences), and the billing (pricing) of such a purchase in accordance to the characteristics of the purchase, say numbers and occurrences.

10. Regarding claims 48, 51, 57, 58, 63, 64, and 67, Scanlon teaches the exclusive combination of the ticket for the occurrence. In column 5:18-33 Scanlon talks about a method to avoid duplicating tickets, and if so indicating the number of duplicates in existence. In column 5:53-55, Scanlon teaches preventing the sell of duplicate tickets.
11. Regarding claims 55-56, 65, and 66 Scanlon teaches, a ticket identifier and the transmission and printing of the ticket information to a terminal. (Col 5:55-65).
12. Regarding claim 62 Scanlon teaches, using a random set of symbols. (Col 4:21-24).

Scanlon fails to teach:

13. Regarding claims 45, and 51-54, Scanlon fails to teach the limitation of the number of duplicate tickets.

Our Opinion 4/9/98 teaches:

14. Regarding claim 45, and 51-54, Our Opinion 4/9/98 teaches the indication and agreement with the costumer at the time of purchase of the limits on the number of duplicate tickets sold for that drawing, and the price associated with the transaction.

Motivation:

15. It would have been obvious for one skilled in the art at the time of the invention to incorporate the teachings from Our Opinion 4/9/98 in Scanlon to limit the number of duplicate tickets so that the winning prize is guaranteed to be of a minimum amount and maintain costumer satisfaction, other reasons for motivation are also mentioned in the Our Opinion 4/9/98 reference.

***Response to Arguments***

16. Applicant's arguments filed 03/06/2006 have been fully considered but they are not persuasive.
17. In regards to arguments for 35 U.S.C 101 rejections, the applicant fails to disclose a tangible result. The examiner fails to see were the applicant creates something other than an imaginary idea. 35 U.S.C. 101 rejections for claims 45-64, 66, and 67 stand rejected.
18. In regards to the objection to claim 60, the amendment to claim 52 necessitated new grounds of rejection making argument moot.
19. In regards to the argument directed to claims 36-44, the argument is moot since applicant elected to cancel claims 36-44.
20. In regards of claims 52-59 and 61-64 rejections, the amendment to claim 52 filed on 03/06/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Scanlon reference, thus rejections for claims 52-59, and 61-64 stand.
21. In regards to new claims 65 and 67 argument is moot due to the new grounds of rejection.

***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Leiva whose telephone number is (571) 272-2460. The examiner can normally be reached on M-Th 8:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

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